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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,355	07/12/2000	Michael L. O'Banion	0275A0103COF	2199

7590 01/29/2003

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/614,355

Applicant(s)

Miller et al.

Examiner

Clark F. Dexter

Art Unit

3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Dec 26, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: None
- Claim(s) objected to: None
- Claim(s) rejected: 1, 10, 11, 14, 15, and 22-26
- Claim(s) withdrawn from consideration: 2-7
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: Attachment- Notice of References Cited (PTO-892)

CLARK F. DEXTER  
PRIMARY EXAMINER  
ART UNIT 3724

**ATTACHMENT TO ADVISORY ACTION (paper no. 16)**

***Terminal Disclaimer***

1. The terminal disclaimer filed on December 26, 2002 (paper no. 15) disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U. S. Patent No. 5,297,463 has been reviewed and is NOT accepted for the following reason(s):

The person who signed the terminal disclaimer is not of record. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

***Response to Arguments***

2. Applicant's arguments filed December 26, 2002 have been fully considered but they are not persuasive.

35 USC 112, 1st paragraph:

In response to the rejection, applicant argues that sufficient support for the claimed structure is found in the original disclosure, specifically on beginning on page 13, line 10 which describes Figure 10. Applicant's position is that Figure 10 schematically illustrates the provision

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of a laterally adjustable fence portion on each lateral side of an exemplary compound miter saw according to the invention. Applicant concludes that “[T]hus the specification supports movement to a second and third position.” The Examiner respectfully disagrees with applicant’s analysis. It is emphasized that the Examiner’s position is not that the original disclosure does not provide sufficient support for a fence which accommodates saw movement to a second and third position as claimed. Rather, the Examiner’s position is that the original disclosure does not provide sufficient support for a miter saw which is movable to a second and third position as claimed. That is, a miter saw capable of such movement was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is noted that this rejection may be equally applicable under the “non-enabling disclosure” portion of 35 USC 112, 1st paragraph. To obviate this rejection, applicant must provide the specific miter saw structure that provides for movement to the claimed second and third positions, and state that such structure is old and well known in the art to avoid adding new matter.

35 USC 103(a):

In response to the prior art rejection, applicant argues that the prior art of record, specifically Brundage et al., does not disclose a miter saw that can move for a bevel cut to either side of the saw as now claimed in Claim 1 and 22. However, the Examiner maintains that such a saw configuration is old and well known in the art. For example, Meek et al., pn 1,646,589, and

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Edler, pn 3,302,669, each disclose saws which can perform compound miter/bevel cuts where the bevel angle can be set by moving the blade to either the left side or the right side (second and third positions).

cf  
January 23, 2003

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